

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ALAN M. WARSHAWSKY and
MICHAEL J. JANUSZ

Appeal No. 2003-1245
Application No. 09/467,292

ON BRIEF¹

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 13. Claim 18, which is the only other claim remaining in the application, stands allowed.

A copy of the claims on appeal appears in Exhibit A attached to applicants' Appeal Brief.

The references relied on by the examiner are:

¹ The oral hearing, originally scheduled February 17, 2004, has been vacated. See Paper No. 30.

Karanewsky et al. (Karanewsky) 5,552,397 Sep. 3, 1996

Robl et al. (Robl), "Dual Metalloprotease Inhibitors, 6. Incorporation of Bicyclic and Substituted Monocyclic Azepinones as Dipeptide Surrogates in Angiotensin-converting Enzyme/Neutral Endopeptidase Inhibitors," J. Med. Chem., Vol. 39, pp. 494-502 (1996)

Claims 1 through 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Robl or Karanewsky.

Discussion

The examiner's rejection is based on the premise that each cited reference discloses "ring position isomers" of applicants' claimed compounds ("the claimed compounds differ from the prior art compounds by being ring position isomers"). Paper No. 22, page 4, lines 3 and 4. The examiner argues that it would have been prima facie obvious to modify the compounds of Robl or Karanewsky by moving variable R₂ (Applicants' nomenclature) to the 5-position of the azepinone ring. By modifying the prior art compounds in this manner, according to the examiner, a person having ordinary skill would have arrived at the claimed invention with a reasonable expectation of providing useful cardiovascular agents.

The premise of the rejection, however, is flawed. On this record, the examiner has not established that each cited reference discloses ring position isomers of applicants' claimed compounds. For example, the examiner invites attention to Robl, page 497, Table 2, compounds having Formula 2. But those compounds have a benzyl group at the α -position of the amide substituent on the illustrated azepinone moiety. As correctly pointed out by applicants, in claim 1 on appeal, variable R₃ at the α -position of

the amide substituent on the azepinone moiety precludes benzyl (Paper No. 19, page 9, last paragraph). By the same token, the title compound of Example 64 disclosed by Karanewsky has a benzyl group at the α -position of the amide substituent on the azepinone ring. Again, the examiner has not established that Karanewsky discloses ring position isomers of applicants' claimed compounds. The examiner has not established that any compound disclosed by Karanewsky, including the compound of Example 64, is in all respects identical to a compound within the scope of appealed claim 1 except for the position of variable R_2 (applicants' nomenclature) on the azepinone ring.

Where, as here, the premise of the examiner's rejection is incorrect, the rejection cannot stand. Accordingly, the rejection of claims 1 through 13 under 35 U.S.C. § 103(a) as unpatentable over Robl or Karanewsky is reversed.

Other Issue

In Paper No. 8, received February 12, 2001, applicants submitted an amendment to independent claim 1 canceling the recitation of variable R_3 as " C_1 - C_6 alkyl." It is apparent therefore that claim 8, which depends from claim 1 and recites " R_3 is C_1 - C_6 alkyl," constitutes an improper dependent claim and should be canceled.

On return of this application to the Examining Corps, we recommend that applicants and the examiner cooperate in resolving this informal matter.

Conclusion

In conclusion, for the reasons set forth, the examiner's decision is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

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